

ESTTA Tracking number: **ESTTA683052**

Filing date: **07/10/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218363
Party	Defendant MR. FOAMER, INC.
Correspondence Address	ISABELLE JUNG CAREY RODRIGUEZ GREENBERG & O'KEEFE LLP 7900 GLADES RD STE 520 BOCA RATON, FL 33434-4105 UNITED STATES pto@crgolaw.com, ijang@crgolaw.com
Submission	Answer
Filer's Name	Isabelle Jung
Filer's e-mail	ijung@crgolaw.com
Signature	/Isabelle Jung/
Date	07/10/2015
Attachments	Answer_Amended_Opposition.pdf(121486 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Opposition No. 91218363

NEW WAVE INNOVATIONS INC.

vs.

MR. FOAMER, INC.

---

**MR. FOAMER’S ANSWER TO AMENDED NOTICE OF OPPOSITION WITH  
AFFIRMATIVE DEFENSES**

MR. FOAMER, INC. (“MR. FOAMER” or “Applicant”) submits this Answer with Affirmative Defenses (“Answer”) to Opposer NEW WAVE INNOVATIONS, INC. (“NEW WAVE” or “Opposer”) Amended Opposition filed on November 13, 2014 (“Amended Opposition”), with the following numbered Paragraphs corresponding to the numbers of the Paragraphs of the Amended Opposition under the headings used in the Amended Opposition:

**Nature of the Action**

1. Applicant admits the allegations in Paragraph 1.
  - A. There is Likelihood of Confusion in the marketplace – Count I
    - Applicant denies the allegations in Paragraph 1.A. first indent;
    - Applicant admits that, in July 2012, Applicant adopted “Mr. Foamer” as its corporate name. Applicant admits that, in August 2012, Applicant started using the MR. FOAMER mark in commerce in connection with its services, namely, online retail store services featuring car wash equipment and parts. Applicant denies the remaining allegations in Paragraph 1.A. second indent;

- Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 1.A. third indent;
- Applicant admits that the parties' commercial car wash products and services are offered and distributed through the same channels of trade to virtually the same customers. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 1.A. fourth indent and therefore denies the remaining allegations in Paragraph 1.A. fourth indent;
- Applicant denies that Opposer owns two pending trademark applications for the MR. FOAMER mark as one of Opposer's applications is currently abandoned (Appl. Serial No. 86303800). Applicant also denies that the trademark applications filed by Opposer are awaiting examination as both applications have been examined, one is currently abandoned (Appl. Serial No. 86303800), and one is currently suspended pending the outcome of the present trademark application which is subject to the Amended Opposition (Appl. Serial No. 86304665). Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 1.A. fifth indent;
- Applicant denies the allegations in Paragraph 1.A. sixth indent.

B. The FOAMER's Trademark Application Must Be Stricken For Fraud Upon The Trademark Office – Count II

- Applicant denies the allegations in Paragraph 1.B. first indent. The representation made by the Applicant in the MR. FOAMER application

(Appl. Serial No. 86/108,666, the “Application”) are found in the Application;

- Applicant denies the allegations in Paragraph 1.B. second indent. The representation made by the Applicant in the Application are found in the Application;
- Applicant denies the allegations in Paragraph 1.B. third indent. The representation made by the Applicant in the Application are found in the Application;
- Applicant admits that Isabelle Jung is the attorney who filed the Application and that Isabelle Jung is also one of the attorney of record in the Federal action filed by the Opposer against the Applicant in the Federal District Court, Southern District of Florida, Case No. 1:13-cv-22541, now closed (the “Federal Case”). The Applicant denies the remaining allegations in Paragraph 1.B. fourth indent;
- Applicant admits that, in the Federal Case, Opposer asserts a claim of common law trademark infringement against Applicant. Applicant denies the remaining allegations in Paragraph 1.B. fifth indent and refers the Board to Docket Entry 136 of the Federal Case (Exhibit 7 to the Amended Opposition) for an accurate listing of the claims made by Opposer against Applicant;
- Applicant denies the allegations in Paragraph 1.B. sixth indent.

### **Parties**

1. The Applicant admits that the Opposer is a California corporation with a principle

place of business in Lodi, California, and that the Opposer designs, engineers and manufactures products for automatic commercial car washes. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 1;

2. The Applicant admits that the Opposer markets and distributes its car wash products in commerce. The Applicant denies that the Opposer markets and distributes its car wash products under the MR. FOAMER mark;

3. The Applicant admits that James McClimond (“McClimond”) is an individual. The Applicant denies the remaining allegations of Paragraph 3;

4. The Applicant denies that Car Wash Experts, Inc. (“Car Wash Experts”) is a Florida corporation, as Car Wash Experts was administratively dissolved as of September 26, 2014. The Applicant admits that, when in corporate existence, Car Wash Experts manufactured, distributed and marketed automatic commercial car wash products and for a limited time period sold a limited quantity of the products manufactured by the Opposer. The Applicant denies the remaining allegations of Paragraph 4;

5. The Applicant admits that the Applicant is a Florida corporation, organized and existing under the laws of the State of Florida; and was founded by McClimond to manufacture, market and distribute automatic commercial car wash products. The Applicant denies the remaining allegations of Paragraph 5.

### **COUNT I**

6. The Applicant refers to the responses, admissions and denials made in Paragraphs 1-4 above;

7. The Applicant admits that McClimond, acting on behalf of Car Wash Experts, contacted the Opposer to inquire as to the products sold by the Opposer. The Applicant denies

the remaining allegations of Paragraph 7;

8. The Applicant admits that, from November 2011 through March 2012, Car Wash Experts ordered approximately \$7,000.00 in automatic car wash products from the Opposer. The Applicant denies the remaining allegations of Paragraph 8;

9. The Applicant denies the allegations in Paragraph 9. The Christmas card shown in Exhibit 2 is not dated 2011 but instead is dated 2014;

10. The Applicant denies receiving a Christmas card from the Opposer in December 2011. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 10 and therefore denies these allegations;

11. The Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 11, and therefore denies the allegations in Paragraph 11;

12. The Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 12, and therefore denies the allegations in Paragraph 12;

13. The Applicant admits that the Opposer has used the term MR. FOAMER on a Halloween card as shown in Exhibit 4. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 13, and therefore denies the allegations in Paragraph 13;

14. The Applicant admits that the Opposer uses the term MR. FOAMER to refer to a promotional figure/character (typically dressed in holiday/seasonal garb or regalia). The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 14, and therefore denies the allegations in Paragraph 14;

15. The Applicant admits that the Opposer uses the term MR. FOAMER to refer to a promotional figure/character (typically dressed in holiday/seasonal garb or regalia). The

Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 15, and therefore denies the allegations in Paragraph 15;

16. The Applicant denies that the dates of first use listed in the trademark applications filed by the Opposer are correct. The Applicant admits the remaining allegations made in Paragraph 16;

17. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 17, and therefore denies the allegations in Paragraph 17;

18. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 18, and therefore denies the allegations in Paragraph 18;

## **COUNT II**

19. The Applicant refers to the responses, admissions and denials made in Paragraphs 1-4 above;

20. The Applicant admits that the Applicant and the Opposer are competitors, and that each manufacture and distribute commercial car wash foam generators and accessories. The Applicant denies the remaining allegations in Paragraph 20;

21. The Applicant admits the allegations of Paragraph 21;

22. The Applicant admits the allegations of Paragraph 22;

23. See response above at Paragraph 1.B. fourth indent;

24. The Applicant admits that on October 29, 2013, a hearing on the Opposer's motion for a preliminary injunction was held in the Federal Case. The Applicant denies the remaining allegations of Paragraph 24;

25. a. The Applicant denies that the Applicant made a “fair use” defense as stated in Paragraph 25 a. The Applicant admits to the remaining allegations in Paragraph 25 a.;

b. The Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations of Paragraph 25 b. as no Exhibit 9 was attached to the Amended Opposition, and therefore denies the allegations in Paragraph 25 b.;

26. The Applicant admits that the Application was filed in connection with three classes of goods and services including “car wash cleaning and polishing preparations.” The Applicant denies the remaining allegations in Paragraph 26;

27. The Applicant denies the allegations in Paragraph 27;

28. The Applicant admits that the Applicant provided specimens of use showing use of the MR. FOAMER mark in connection with the services offered by the Applicant when filing the Application. The Applicant denies the remaining allegations of Paragraph 28;

29. The Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 29 and therefore denies the allegations in Paragraph 29;

30. The Applicant denies the allegations of Paragraph 30;

31. The Applicant admits that the Opposer has filed a motion to strike in the Federal Case. The Applicant denies the remaining allegations contained in Paragraph 31;

32. The Applicant denies the allegations of Paragraph 32;

33. The Applicant denies the allegations of Paragraph 33;

34. The Applicant denies the allegations of Paragraph 34.



## **AFFIRMATIVE DEFENSES**

### **First Affirmative Defense**

#### **Lack of Priority of Use of the MR. FOAMER Mark by the Opposer**

The alleged use of the MR. FOAMER mark by the Opposer to refer to a cartoon character on a Christmas card does not amount to valid trademark use of the MR. FOAMER Mark in commerce from which trademark rights can arise. As such, the Opposer has no trademark rights in the MR. FOAMER Mark and the date of first use listed in the trademark application for the MR. FOAMER Mark filed by the Opposer (Appl. Serial No. 86/304,665, the “Opposer’s Application”) is a misrepresentation of fact as no use in commerce of the MR. FOAMER Mark has ever been made by the Opposer. Because no use of the MR. FOAMER Mark has ever been made by the Opposer, the Opposer is not the prior user of the MR. FOAMER Mark in commerce.

### **Second Affirmative Defense**

#### **Fraud in Applying for the MR. FOAMER Mark by the Opposer**

The Opposer’s Application was filed as a “use-based” application where the Opposer represented to the United States Patent and Trademark Office that the Opposer had used the MR. FOAMER Mark in connection with “online retail store services featuring car wash equipment and parts thereof” as early as December 15, 2011. However, the Opposer has not used the MR. FOAMER Mark in connection with an online retail store since December 15, 2011. The only *de minimis* use of the term MR. FOAMER by the Opposer was made to refer to a cartoon character in the Opposer’s Christmas card. Such use does not amount to trademark use and certainly not amount to use in commerce of the MR. FOAMER mark in connection with an online retail store. Therefore, the Opposer has filed the Opposer’s Application fraudulently, the Amended

Opposition should be stricken and the Opposer's Application should be stricken.

**Third Affirmative Defense**  
**The Opposer's Second Application is Now Abandoned and Cannot Serve as a Basis for the Amended Opposition**

The Opposer has filed a second application for "Christmas Wishes from Mr. Foamer & design" (Appl. Serial No. 86/303,800, the "Opposer's Second Application"). The Opposer's Second Application is now abandoned and a notice of abandonment was mailed to the Opposer on April 21, 2015. Therefore, reference to the Opposer's Second Application should be stricken from the Amended Opposition and the Opposer's Second Application cannot serve as a basis for the Amended Opposition.

Dated: July 10, 2015

Respectfully submitted,  
/s/ Isabelle Jung  
Isabelle Jung  
[ijung@crgolaw.com](mailto:ijung@crgolaw.com)  
CRGO Law  
7900 Glades Road, Suite 520  
Boca Raton, FL 33434  
Tel. 561-922-3845  
Fax. 561-244-1062

### **CERTIFICATE OF SERVICE**

I hereby certify that this Answer to the Amended Notice of Opposition with Affirmative Defenses is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below. I hereby further certify that on the date indicated below true and complete copy of this Answer with Affirmative Defenses has been served on opposing counsel listed below by electronic mail.

/s/ Isabelle Jung  
Isabelle Jung  
July 10, 2015

John H. Faro  
[johnf75712@aol.com](mailto:johnf75712@aol.com)  
[john75712@gmail.com](mailto:john75712@gmail.com)